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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,447	02/11/2002	Andrew R. Jamieson	3139-011903	4537

7590

04/08/2003

Russell D. Orkin
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EXAMINER

KIZILKAYA, MICHELLE R

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 04/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,447

Applicant(s)

JAMIESON

Examiner

KIZILKAYA

Group Art Unit

1661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☐ Responsive to communication(s) filed on 2/11/02
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other PR. FOR INFO, 105

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DETAILED ACTION

Status of the Application

Applicant's request for corrected filing receipt has been received and entered.

Objection to the Disclosure

35 U.S.C. 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

Claim Rejection

35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. 102(a) based on the invention having been known or used by others here in the U.S., or patented or described in a printed publication in or outside the U.S. more than one year prior to filing of the instant application.

Claim 1 rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention.

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35 U.S.C. 102

The claimed Strawberry variety 'Evangeline' is described in Breeder's Right grant number 0617 granted in Canada on May 3, 1999. The publication of the grant took place on August 10, 1999 and the denomination was proposed on June 30, 1998. The application was filed on March 13, 1997 and then published on April 30, 1997, more than one year prior to the filing date of the instant application.

The published application, grant and denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 794 (CCPA 1981). See also MPEP § 2128.

For example, UPOV publishes the application number, grant number, date of publication, species of plant, and variety denomination for PBR certificates, and copies of the each grant are obtainable in Canada. All documents relating to the application are open for public inspection. Thus information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

A printed publication can serve as a statutory bar under 35 U.S.C. 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ 365 (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ 2d

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1618, 1620, (Bd. Pat. App. & Inter. 1992)(“The issue is not whether the [claimed] cultivar Siokra was on public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”).

While the publications cited above disclose the claimed plant variety, a question remains as to whether the references are enabling. If the plant was publicly available, then the published application, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. The ability of the Office to determine whether the claimed plant was publicly available is limited.

Search of electronic databases, the Internet and the Office’s collection of retail catalogs appears to have revealed evidence that the claimed plant was on sale and available. Furthermore, the claimed plant may have been sold at the wholesale level, sold under a different name, or even distributed to interested parties free of charge. As per the enclosed references it would seem the claimed plant was made publicly available.

Examiner is requiring this information in the attached Requirement for Information Under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

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Future Correspondence

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michelle R. Kizilkaya whose telephone number is (703) 308-4324. The Examiner can normally be reached Monday through Friday from 9:00 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205.

The fax phone number for the group is (703) 305-3014 or 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

M. R. Kizilkaya / mrk

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REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined reasonably necessary to the examination of this application.

The information is required to determine when, if ever, the claimed plant variety, 'Brunswick', was publicly available prior to the filing date of the instant application.

In response to this requirement please provide any information available regarding the sale or other public distribution of the claimed plant variety anywhere in the world, including the date(s) of any sale or other public distribution. Also, please provide copies of the published applications, published proposed denomination, and published Breeder's Right grants. The Office does not maintain a collection of Breeders' Rights documents and they are not readily obtainable electronically. Since the assignee of the instant application is listed by UPOV as applicant, breeder and title holder of the granted Breeders Right (grant number 0618) it is reasonable to expect that Applicant or assignee can readily obtain the requested document and information.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first

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communication responding to this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

Applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is three months.

A handwritten signature in black ink, appearing to read "Bruce Campell", is positioned above the printed name and title.

BRUCE R. CAMPPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600